



RCE/1600

PTO/SB/30 (05-03)  
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**Request  
For  
Continued Examination (RCE)  
Transmittal**

Address to:  
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P.O. Box 1450  
Alexandria, VA 22313-1450

Application Number	09/700,732
Filing Date	March 19, 2001
First Named Inventor	Whitcombe et al.
Art Unit	1655
Examiner Name	A. Chakrabarti
Attorney Docket Number	0380-P02328US0

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**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**  
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114** Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).
- a. ☒ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.
- i. ☐ Consider the arguments in the Appeal Brief or Rely Brief previously filed on \_\_\_\_\_
- ii. ☒ Other Amendment and Request for Reconsideration Under 37 C.F.R. 1.116
- b. ☒ Enclosed
- i. ☐ Amendment/Reply
- iii. ☐ Information Disclosure Statement (IDS)
- ii. ☐ Affidavit(s)/ Declaration(s)
- iv. ☒ Other Comments on Advisory Action
2. **Miscellaneous**
- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of \_\_\_\_\_ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)
- b. ☐ Other \_\_\_\_\_
3. **Fees** The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.
- a. ☒ The Director is hereby authorized to charge any deficiency in the following fees, or  
Deposit Account No. 04-1406 credit any overpayments, to:
- i. ☒ RCE fee required under 37 CFR 1.17(e) 07/01/2003 COMM1 00000132 09700732
- ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17) 02 FC:1601 750.00 DP
- iii. ☐ Other \_\_\_\_\_
- b. ☒ Checks in the amount of \$750.00 (RCE Fee) and \$410.00 (Extension Fee) are enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Name (Print/Type)	Patrick J. Hagan	Registration No. (Attorney/Agent)	27,643
Signature	<i>Patrick J. Hagan</i>	Date	June 26, 2003

**CERTIFICATE OF MAILING OR TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

Name (Print/Type)	Kimberly St. Clair Kelley	Date	June 26, 2003
Signature	<i>Kimberly St. Clair Kelley</i>		

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : David Mark Whitcombe et al  
Serial No. : 09/700,732  
Filing Date : March 19, 2001  
Examiner : A. Chakrabarti  
Group Art Unit : 1655  
Entitled : NUCLEIC ACID SEQUENCE  
IDENTIFICATION

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Our File No. 0380-P02328US0  
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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**COMMENTS ON ADVISORY ACTION**

Dear Sir:

Applicants hereby submit the following comments on the Advisory Action, dated May 21, 2003, in the above-identified patent application:

1. The characterization of U.S. Patent No. 6,127,120 as "new prior art" in the May 21, 2003 Advisory Action is inaccurate, as the '120 patent is the U.S. national stage of WO 97/05280, on which the Examiner relied in rejecting claims 1-6, 8-13, 15-20 and 37 in the Final Rejection set forth in the Official Action dated August 27, 2002. Thus, any further lack of novelty rejection based on the '120 patent would be

superfluous. This so-called "new prior art" certainly does not warrant the Examiner's refusal to enter applicants' claim amendments under 37 C.F.R. §1.116.

2. The mere mention of aggregation of metal associated with SER(R)S in the '120 patent does not provide a basis for rejecting applicants' claims in any case. Applicants' claims do not simply call for aggregation of metal associated with SER(R)S, but instead recite "aggregation of said metal SER(R)S surface being dependent on the presence of said target nucleic acid in said sample". This feature, among others, clearly distinguishes applicants' invention over that of WO 97/05280, for the reasons set forth at pages 11-14 of the Amendment and Request for Reconsideration Under 37 C.F.R. §1.111, filed July 25, 2002 in response to the Official Action dated February 27, 2002, which reasons are incorporated by reference herein.

Respectfully submitted,

DANN DORFMAN HERRELL &  
SKILLMAN, P.C.

By: Patrick J. Hagan  
Patrick J. Hagan  
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PJH:ksk